

REMARKS/ARGUMENTS

The Office Action mailed January 25, 2005 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested. The claims presented for examination are: claims 1-3 and 8-11. Applicant has amended all of claims presented for examination, claims 1-3 and 8-11.

Allowed Claims 1-3 and 8-11

In numbered paragraph 4 of the Office Action mailed November 4, 2004, claims 1-3 and 8-11 were allowed; however, in the Office action mailed December 15, 2004 the claims were stated to raise a 112 1st/101 operability question. In numbered paragraph 1 of the Office Action mailed January 3, 2005, it was stated that "the amendment to the claims does overcome the 112/101 rejection..."

Objections to Specification

In numbered paragraph 2 of the Office Action mailed January 3, 2005, claim 2 was objected to under 37 CFR 1.759(c), as being of improper dependent form for failing to limit the subject matter of a previous claim. Applicants have amended claim 2 to clarify that "said laser means comprises multiple laser sources and means that generate an optical emission signal and an optical reference signal." This limits the subject matter of the parent claim 1. Applicants believe they have provided a full and complete response to the objection to claim 2 as being of improper dependent form in numbered paragraph 4 of the Office Action mailed January 3, 2005.

In numbered paragraph 3 of the Office Action mailed January 3, 2005, it was stated, "The attempt to incorporate subject matter into this application by reference to 09/xxx,xxx in page 11 of the current application is improper because applications for patents are confidential and hence cannot be incorporated by

reference.” Applicants have amended the specification to include the publication information for the Hular application, as follows: “described in U.S. Patent Application Number 2003/0045798 by Richard Hular et al, published March 6, 2003.” Applicants believe they have provided a full and complete response to the objection to the specification regarding the Hular application in numbered paragraph 4 of the Office Action mailed January 3, 2005.

35 USC 112 Rejection in Paragraph 5

In numbered paragraph 5 of the Office Action mailed January 3, 2005, claims 1-3 and 8-11 were rejected under 35 USC 112, second paragraph, as being incomplete for omitting essential elements. It was stated, “The omitted elements are: the splitters(s) and the interconnecting optical fibers including the emission and reference optical fibers and the optical fibers associated with the detectors.”

Applicants respectfully traverse the rejection of claims 1-3 and 8-11 in numbered paragraph 5 of the Office Action mailed January 3, 2005 as being incomplete for omitting essential elements. Claims 1-3 and 8-11 include the essential elements. For example, claim 1 includes “a transmission system including an emission optical fiber connected to said laser means, to said probe, to said needle, and to said emission optical detector that transmits said emission signal to said probe, to said needle, and from said probe to the tissue for characterizing the tissue, and from the tissue to said needle, to said probe and to said emission optical detector, and a reference optical fiber connected to said laser means, to said probe, and to said reference optical detector that transmits said reference signal to said probe and from said probe to said reference optical detector,” which provide claim 1 with the essential elements. Claim 6 includes the element, “said laser means includes an optical splitter that splits said emission signal and said reference signal.”

Applicants believe they have provided a full and complete response to the rejection of claims 1-3 and 8-11 under 35 USC 112, second paragraph, as being incomplete for omitting essential elements in numbered paragraph 5 of the Office Action mailed January 3, 2005.

35 USC 112 Rejection in Paragraph 6

In numbered paragraph 6 of the Office Action mailed January 3, 2005, claims 1-3 and 8-11 were rejected under 35 USC 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements. It was stated, "The omitted structural cooperative relationships are: the interrelations between the optical fibers connecting the emission, the reference and the detector optical fibers."

Applicants respectfully traverse the rejection of claims 1-3 and 8-11 in numbered paragraph 6 of the Office Action mailed January 3, 2005 as being incomplete for omitting essential structural cooperative relationships of elements. Claims 1-3 and 8-11 include the essential structural cooperative relationships of elements. For example, claim 1 includes "a transmission system including an emission optical fiber connected to said laser means, to said probe, to said needle, and to said emission optical detector that transmits said emission signal to said probe, to said needle, and from said probe to the tissue for characterizing the tissue, and from the tissue to said needle, to said probe and to said emission optical detector, and a reference optical fiber connected to said laser means, to said probe, and to said reference optical detector that transmits said reference signal to said probe and from said probe to said reference optical detector," which provide claim 1 with the essential structural cooperative relationships of elements.

Applicants believe they have provided a full and complete response to the rejection of claims 1-3 and 8-11 under 35 USC 112, second paragraph, as being

incomplete for omitting essential structural cooperative relationships of elements in numbered paragraph 6 of the Office Action mailed January 3, 2005.

35 USC 112 Rejection in Paragraph 8

In numbered paragraph 8 of the Office Action mailed January 3, 2005, claims 1-3 and 8-11 were rejected under 35 USC 112, first paragraph, as based on a disclosure which is not enabling. It was stated, "The splitters 33 and/or 50 and 52 and the optical fibers are critical or essential to the practice of the invention, but not included in the claims(s) is not enabled by the disclosure."

Applicants respectfully traverse the rejection of claims 1-3 and 8-11 in numbered paragraph 8 of the Office Action mailed January 3, 2005 as based on a disclosure which is not enabling. The disclosure describes the invention and the claims include the essential elements. For example, claim 1 includes "a transmission system including an emission optical fiber connected to said laser means, to said probe, to said needle, and to said emission optical detector that transmits said emission signal to said probe, to said needle, and from said probe to the tissue for characterizing the tissue, and from the tissue to said needle, to said probe and to said emission optical detector, and a reference optical fiber connected to said laser means, to said probe, and to said reference optical detector that transmits said reference signal to said probe and from said probe to said reference optical detector," which provide claim 1 with the essential elements. Amended claim 8 includes the element, "said laser means includes an optical splitter means for producing said emission signal and said reference signal."

35 USC 101 Rejection in Paragraph 10

In numbered paragraph 10 of the Office Action mailed January 3, 2005, claims 1-3 and 8-11 were rejected under 35 USC 101, as inoperative and therefore lacks utility. It was stated, "...there are two different embodiments reflected by

Figures 2 and 3, having a single splitter 34 or two splitters 50 and 52, respectively, which are essential for the generation of the emission and the reference signal, which are not claimed."

Applicants respectfully traverse the rejection of claims 1-3 and 8-11 in numbered paragraph 10 of the Office Action mailed January 3, 2005 as inoperative. The disclosure describes the invention and the claims include the essential elements. For example, claim 1 includes "a transmission system including an emission optical fiber connected to said laser means, to said probe, to said needle, and to said emission optical detector that transmits said emission signal to said probe, to said needle, and from said probe to the tissue for characterizing the tissue, and from the tissue to said needle, to said probe and to said emission optical detector, and a reference optical fiber connected to said laser means, to said probe, and to said reference optical detector that transmits said reference signal to said probe and from said probe to said reference optical detector," which provide claim 1 with the essential elements.

Applicants believe they have provided a full and complete response to the rejection of claims 1-3 and 8-11 under 35 USC 101, as being incomplete in numbered paragraph 10 of the Office Action mailed January 3, 2005.

35 USC 101 Rejection in Paragraph 11

In numbered paragraph 11 of the Office Action mailed January 3, 2005, claims 1-3 and 8-11 were rejected under 35 USC 101, because the claimed invention is directed to non-statutory subject matter. It was stated, ".... the use of the terminology 'a needle that is inserted in the tissue' inferentially claims the human body. The Examiner suggests changing the language to - - a needle that is adapted to be inserted into the tissue - -."

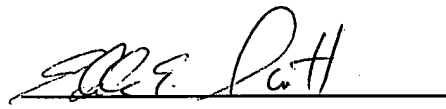
Applicants have amended the claims to state that "a needle that is adapted to be inserted into the tissue" as suggested by the Examiner.

Applicants believe they have provided a full and complete response to the rejection of claims 1-3 and 8-11 under 35 USC 101, as directed to non-statutory subject matter in numbered paragraph 11 of the Office Action mailed January 25, 2005.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the issues raised in the Office Action dated January 25, 2005 have been fully addressed and overcome. The present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Eddie E. Scott", is written over a horizontal line.

Eddie E. Scott
Attorney for Applicant
Registration No. 25,220
Tel. No. (925) 424-6897

Livermore, California

Dated: February 16, 2005